

## **REMARKS/ARGUMENTS**

### **Introduction:**

Claims 94, 98, 97, and 99 are amended, and claims 27-32, 34, 37-40, 43-47, 49-72, 86, 88, 93, 95, 96, and 100-102 are or were previously canceled. In addition, claims 105-110 are newly added. Claims 26, 33, 35, 36, 41, 42, 48, 73-85, 87, 89-92, 94, 97-99, and 103-110 are now pending in the application. Applicants respectfully request reexamination and reconsideration of the application.

### **Rejections Under 35 USC § 112, First Paragraph:**

Claims 100-104 were rejected under 35 USC § 112, first paragraph as allegedly containing subject matter not supported by the specification and drawings. For reasons unrelated to this rejection, claims 100-102 were canceled, mooted the rejection of claims 100-102. Applicants respectfully traverse the rejection of claims 103 and 104.

The MPEP sets forth the test for determining whether a specification meets the written description requirement of the first paragraph of 35 USC § 112 as follows:

The test for sufficiency of support . . . is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." (MPEP § 2163.02.)

In one non-limiting example, Figures 8A-8E of the specification illustrate a probe that comprises a body 826 and a tip 830. The specification states that the body 826 can be made of, among other materials, nickel (specification pg. 40, lines 9 and 10). Nickel is not a palladium cobalt alloy. Therefore, by disclosing that the body 826 can be nickel, the specification necessarily discloses an embodiment of the body 826 that is not palladium cobalt. The foregoing is more than sufficient to convey to a person of ordinary skill in the field that the inventors of the instant application had possession of an embodiment having a body 826 made of nickel—not palladium cobalt. The specification thus fully meets the written description requirement for claims 103 and 104.

**Rejections Under 35 USC § 103(a):**

Claims 26, 33, 36, 41, 42, 48, 73-85, 87, 89-92, and 94-104 were rejected under 35 USC § 103(a) as obvious in view of US Patent No. 5,810,609 to Faraci et al. ("Faraci") in combination with one or more of US Patent No. 5,632,631 to Fjelstad ("Fjelstad"), US Patent No. 5,180,482 to Abys et al. ("Abys"), U.S. Patent No. 5,476,818 to Yanof ("Yanof"), or U.S. Patent No. 5,177,438 to Littlebury ("Littlebury"). In addition, claims 26, 33, 36, 41, 42, 73-85, 87, 89-92, and 94-104 were rejected under 35 USC § 103(a) as obvious in view of U.S. Patent No. 5,811,982 to Beaman ("Beaman") in combination with one or more of Fjelstad, Abys, Yanof, or Littlebury. Applicants respectfully traverse these rejections.

Independent claims 26 and 42 recite "palladium cobalt." In the Office Action, the PTO acknowledges that none of Faraci, Beaman, Fjelstad, Yanof, or Littlebury discloses use of palladium cobalt. The PTO states, however, that the alleged disclosure of "palladium alloys" in Yanof, Littlebury, and Faraci *per se* renders the recitation of palladium cobalt in claims 26 and 42 obvious unless Applicants establish unexpected results from the palladium cobalt recited in claims 26 and 42. Applicants respectfully assert that the foregoing is a misstatement of the law.

Applicants assert that the rejection of claims 26 and 42 is, or is analogous to, a situation in which a claim recites a species and the prior art discloses a genus to which the species belongs but does not disclose the specific species recited in the claim. According to the MPEP, the PTO does not meet its burden of establishing a *prima facie* case of obviousness by simply insisting that the applicant show unexpected results. Rather, the MPEP states that, "[t]o establish a *prima facie* case of obviousness in genus-species chemical composition situations, as in any other 35 U.S.C. 103 case, it is essential that Office personnel find some motivation or suggestion to make the claimed invention in light of the prior art teachings." (MPEP 2144.08.II.A, pg. 2100-145.) In light of the U.S. Supreme Court's recent decision in *KSR Int'l Co. v. Teleflex, Inc.*, it may be permissible to change the "motivation or suggestion" in the foregoing quote from the MPEP to "a logical reason to modify the prior art to arrive at the claimed invention." The PTO has not pointed to any teaching or suggestion in the prior art to modify Yanof, Littlebury, and Faraci to utilize the specific alloy palladium cobalt. Nor has the PTO provided any logical reason why a person of ordinary skill in the field would modify Yanof, Littlebury, or Faraci to utilize the specific alloy palladium cobalt. Therefore, the PTO has not established a *prima facie* case of obviousness of claim 26 based on any combination with Yanof, Littlebury, or Faraci.

Should the PTO continue to require the submission of unexpected results, Applicants respectfully request that the PTO cite authority—in the form of a section of the MPEP, a promulgated rule, a statute, or a court case—supporting the PTO's position that the generic disclosure of an alloy of a material renders all future claimed uses of every specific alloy of that material obvious absent a showing of unexpected results from the use of a specific alloy.

As a backup, the PTO also cites Abys. As generally discussed in the Amendments filed September 1, 2006 and February 6, 2007, however, it would not have been obvious to combine Abys with Faraci or Beaman as proposed in the Office Action. Abys does not teach or suggest using palladium cobalt in contacts designed for microelectronic circuits like the contacts disclosed in Faraci or Beaman. Abys' teachings are limited to relatively large electrical connectors, like relay contacts and switches or the macro sized contact shown in Figure 1 of Abys. (Abys col. 1, lines 19-21.) In fact, the palladium cobalt disclosed in Abys must be shaped using stamping operations. (Abys col. 2, lines 15-18.) Without question, stamping operations cannot be used in making Faraci's microcontacts 190, 200 or Beaman's test probe 20, which are designed for use with a microelectronic device such as Faraci's device 265 or Beaman's integrated circuit device 30 and must therefore be made using delicate lithographic techniques like those used to form integrated circuits on semiconductor dies or delicate wiring bonding techniques like those used with integrated circuits. (See Faraci Figures 6A-6E and Beaman Figures 3-6.) Abys does not explain how or even hint that its stamped palladium cobalt could or should be used with microelectronic contacts (like Faraci's or Beaman's) fabricated using delicate operations associated with semiconductor devices. Indeed, it would not be possible to apply Abys' teachings regarding shaping palladium cobalt by stamping to use with the micro sized, lithographically produced structures and circuits of Faraci or Beaman. Therefore, it would not have been obvious to combine Abys with Faraci or Beaman as proposed in the Office Action.

For at least the foregoing reasons, independent claims 26 and 42 are patentable over the prior art of record.

Claims 33, 35, 36, 41, 48, 73-85, 87, 89-92, 94, 97-99, and 103-110 depend from claim 26 or claim 42 and, at least because of that dependency, are also patentable over the prior art of record. Moreover, those dependent claims recite additional features not taught or rendered obvious by the prior art of record.

For example, new claim 105 recites that "a first body of a first one of said microelectronic probes overlaps a second body of a second one of said microelectronic probes," and new claim 108 recites generally similar features. The prior art of record does not teach or render obvious such features.

As another example, new claim 107 recites that the "contact tip comprises a base and a truncated pyramid protrusion extending from a surface of the base, and the contact tip and the base are an integral, single structure," and new claim 110 recites similar features. The prior art of record does not teach or render obvious such features.

**Conclusion:**

In view of the foregoing, Applicants submit that all of the claims are allowable and the application is in condition for allowance. If the Examiner believes that a discussion with Applicants' attorney would be helpful, the Examiner is invited to contact the undersigned at (801) 426-2106.

Respectfully submitted,

Date: July 27, 2007

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